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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,855	04/28/2006	David William Taylor	127865	4856
25944	7590	01/30/2009	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			BHAT, ADITYA S	
ART UNIT	PAPER NUMBER			
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,855	<b>Applicant(s)</b> TAYLOR, DAVID WILLIAM
	<b>Examiner</b> ADITYA BHAT	<b>Art Unit</b> 2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 07 November 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 April 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Status***

1. Claims 1-12 are currently pending in this application. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by McMurtry USPUB # 2006/0037208.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

3. The drawings submitted on 4/28/2006 are in compliance with 37 CFR § 1.81 and 37 CFR § 1.83 and have been accepted by the examiner.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by McMurtry USPUB # 2006/0037208

With regards to claim 1, McMurtry USPUB # 2006/0037208 teaches a method of scanning comprising the steps of:

providing a scanning system having a sample holder and a relatively movable scanning device; ( see figure 1)

performing a scan of at least a part of an object located on the sample holder and of at least a portion of a surface of the sample holder; (200; figure 2)

establishing orientation of a plane of the sample holder; (page 2. paragraph 0032) and

interpreting data from the scan using the orientation of the sample holder, the orientation being established using data from the scan of the object. (page 2. paragraph 0036)

With regards to claim 2, McMurtry USPUB # 2006/0037208 teaches the orientation is established by defining a plane of the sample holder. (Page 2. paragraph 0032)

With regards to claim 3, McMurtry USPUB # 2006/0037208 teaches the plane in which orientation is established is limited by boundaries. (limits of motion; page 2. paragraph 0038)

With regards to claim 4, McMurtry USPUB # 2006/0037208 teaches the orientation is established by extracting at least three measurements. (Page 2. paragraph 0042)

With regards to claim 5, McMurtry USPUB # 2006/0037208 teaches the orientation is established by extracting data for **at least 240** degrees around the surface of the sample holder. (Page 2. paragraph 0040) measures in a circular direction (360 degrees)

If applicant believes that measuring 240 degrees to be novel applicant should explain why this specific angular measurement would provide unexpected results or why this specific angle is novel in view of the prior art.

With regards to claim 6, McMurtry USPUB # 2006/0037208 teaches the orientation is established by measuring during a single process. (600,700; figure 2)

With regards to claim 7, McMurtry USPUB # 2006/0037208 teaches the orientation is established by measuring during more than one discrete processes. (600,800; figure 2)

With regards to claim 8, McMurtry USPUB # 2006/0037208 teaches the orientation is established within a defined vertical envelope with respect to the sample holder. (Page 2. paragraph 0025)

With regards to claim 9, McMurtry USPUB # 2006/0037208 teaches a method of scanning comprising:

providing a scanning system having a sample holder (page 2. paragraph 0026)  
and

a relatively movable scanning device; (page 2. paragraph 0025)

scanning a datum; (figure 2)

scanning a sample; and interpreting data from the sample scan using data from the datum scan; (page 2, paragraph 0032)

wherein the scanning system automatically carries out the datum and sample scans. (page 1, paragraph 0011)

With regards to claim 10, McMurtry USPUB # 2006/0037208 teaches a method of scanning comprising:

providing a scanning system having a sample holder and a relatively movable scanning device (page 2. paragraph 0025-0026);

scanning a datum; (figure 2)

scanning a sample; and interpreting data from the sample scan using data from the datum scan; (page 2. paragraph 0032)

wherein both the datum and sample scans are carried out effectively as one scan. (figure 2)

With regards to claim 11, McMurtry USPUB # 2006/0037208 teaches the scan of the object and the scan of at least a portion of the sample holder are conducted as a single scan. (figure 2)

With regards to claim 12, McMurtry USPUB # 2006/0037208 teaches the scanning a datum and the scanning a sample are conducted as a single scan.(figure 2)

#### ***Response to Arguments***

6. Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive.

Applicant is reminded that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and

broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allowed. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In this instance applicant argues that the prior art of record does not teach establishing the orientation of a plane of the sample holder (page 2, paragraph 0030-0031), and scanning a datum and interpreting data from the sample scan using data from the datum scan (page 2, paragraph 0038). Applicant, also argues that the datum scan and datum stop are not the same. Applicant states that the datum scan is scan that is performed and a datum stop is a command that stops the scan. Examiners position is that there must be a datum scan in order for there to be a datum stop. If there is no scan then there would be nothing to stop.

It should also be noted that it would be within reasonable interpretation for one of ordinary skill in the art to conclude that the orientation/position of the sample holder would be known in order to ensure an accurate scan. The position/orientation of the

sample holder must be known in order for the scanner to know where to start/stop a scan.

Applicant's arguments have been reviewed and it is believed that the claimed invention reads on the prior art of record. Therefore the rejection is deemed proper.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mcmurtry (USPUB 2005/0060868) teaches a re-orientatable sample holder.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADITYA S. BHAT whose telephone number is (571)272-2270. The examiner can normally be reached on M-F 9-5:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aditya Bhat/  
Examiner, Art Unit 2863

January 27, 2009

/Bryan Bui/  
Primary Examiner, Art Unit 2863